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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,690	03/07/2001	Li-Lung Chao	YOR920010128US1/127-0007	5054

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Philmore H. Colburn II  
Cantor Colburn LLP  
55 Griffin Road South  
Bloomfield, CT 06002

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/800,690

Applicant(s)

CHAO ET AL.

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The examiner is in receipt of applicant's response to office action mailed 2/23/2004, which was received 5/24/2004. Acknowledgement is made to the amendment to claims 1 and 3-10, and the cancellation of claim 2, leaving claims 1,3-21 as pending in the instant application. Applicant's amendment has been carefully reviewed and was found to be convincing in removing the USC 101 issues contained in claims 1-10. However, the arguments were not persuasive in removing the 101 rejection of claims 10-21 and the rejection of the claims on the merits. Therefore, the following rejection is restated below with further USC 101 comments to help the applicant correct the remaining issues and modifications to the rejection on the merits as were necessitated by amendment.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-21 are rejected under 35 USC 101 because these claims have no connection to the technological arts (i.e. computer, network, data processing, internet, ect.). In this case even though the database could be construed as an electronic database it still does not define any actionable processing and is therefore considered to be a trivial use of technology. To overcome this rejection, the examiner recommends that the applicant amend the claims to incorporate limitations directed to the

Art Unit: 3625

technological arts in the body of the claims. Please note that merely reciting technological limitations in the preamble of the claim is not sufficient to overcome this rejection.

Please note that claims 11-19 have no connection to the technological arts and is a process that can otherwise be done by hand. In regards to claims 20 and 21 these claims are considered to be software per se, because the storage medium is not necessarily capable of causing functional change in the computer, because the storage medium is not a computer-readable medium. Furthermore, it is unclear whether the processor is a computer processor or a person processing the method. The processor needs to be a computer processor processing the code in the storage media. The examiner also suggests that the applicant use computer-readable instead of machine-readable or explain why machine-readable is being used. (MPEP 2106 IV.B.1(a)).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alnwick (US 2002/0007318) in view of Ahluwalia (6,728,685) in view of Pritchard in view of Furphy (2002/0107794) and further in view of Official Notice.**

**In regards to claim 1**, Alnwick discloses a system for back ordering out of stock products, the system comprising:

a user system coupled to said network (FIG 1, item 3); and

said user system accessing said host system via said network (FIG 1).

a host system for receiving an order for a product from a user (FIG 1),

determining whether inventory for said product satisfies said order (abstract, particular component in stock?),

notifying said user if said inventory for said product does not satisfy said order (page 4, line 56),

Alnwick teaches searching for a product and determining if available quantities are in stock (para 56), placing an order for a back ordered quantity that was not available from the current stock (para 76), updating inventory amounts (para 76), having a vendor approve the order (para 86) and tracking status (para 86), but does not specifically mention that the inventory is updated after the back ordered product is received and that the customer is notified. Ahluwalia teaches updating inventory on a regular basis (Ahluwalia, col 11, lines 11-60), and notifying the customer that the item has been received (Ahluwalia, col 10, lines 20-37). It would have been obvious to a

Art Unit: 3625

person having ordinary skill in the art to include in Alnwick, updating the inventory and notifying the customer of the status, because in cases where time is of the essence, such information may be used to notify a customer that the configured product is not readily available. A new order can therefore be placed or a preexisting one updated without the customer having to cancel a previously submitted order (Ahluwalia, col 2, lines 35-60).

The combination of Alnwick and Ahluwalia teach notifying a user of the product availability status (see above) but does not specifically mention that there is a response to the status update and an authorization to deliver the product. Pritchard teaches a customer being notified of the arrival of a back ordered product and authorizing the delivery by obtaining a customer signature (page 2, para 11). This type of notification is notoriously well known in the automobile sales industry, where customers are notified that their back ordered car has arrived. The dealer is obviously motivated to make the call since delivering the car quickly will save money by disposing of the inventory as soon as possible. It was further notoriously well known that the customer could cancel the order at any time as is taught by Ahluwalia (col 35-45). It would have been obvious to a person having ordinary skill in the art to include in the combination of Alnwick and Ahluwalia, notifying the customer and getting authorization to ship, because the customer may no longer need the product due to the late arrival of the product, which caused the customer to purchase the product elsewhere (Ahluwalia col 2, lines 17-23). This notification and approval when done in a timely fashion will permit the product to be immediately placed back in the available inventory so that another customer may

purchase the product, thus reducing the amount of time that the inventory is held by the supplier.

The combination of Alnwick and Ahluwalia teach placing an order for a back ordered quantity that was not available from the current stock (Alnwick, para 76), but does not specifically mention that a time period is placed by the user on the back ordered items from a supplier. Furphy teaches a back order time period designated by a customer (Para 65). It would have been obvious to a person having ordinary skill in the art to include in Alnwick having the capability to allow the customer to cancel an order if the product was not available on a certain date, because this would free both the customer and the supplier from the contract and allow the customer to pursue other suppliers to attain potentially critical parts.

a network coupled to said host system (page 6, para 86); and

a database coupled to said host system for storing data relating to said back ordering out of stock products (page 7, para 94).

**In regards to claim 3**, Alnwick teaches wherein said acquiring said amount and updating said inventory includes said host system:

requesting said amount from a supplier; and

receiving a request from said supplier to add said amount to said inventory (see response to claim 1).

**In regards to claim 4**, Alnwick teaches placing a time limit on an active quote in which after that time the quote expires (para 93) and placing a back order (see response to claims 1-3).

**In regards to claim 5**, Alnwick teaches notifying said user that said back order request will remain on hold for a predetermined time (para 93);

determining whether said predetermined time has expired; and

deleting said back order request if said predetermined time has expired (see response to claim 4 above).

**In regards to claim 6**, Alnwick teaches wherein said delivery request includes said host system:

sending a back order confirmation request to said user;

receiving a back order confirmation; and

reducing said inventory data to reflect said back order confirmation (see response to claims 1-5 above).

**In regards to claims 7 through 21**, these claims and their features are considered parallel claims to claims 1-7 and are rejected to the same reasons as claims 1-7 above.

***Response to Arguments***



Applicant's arguments filed May 24, 2004 have been fully considered but they are not persuasive.

Applicant argues that Alnwick does not teach "receiving a time period request from said user system for setting a time that said back order request is to remain in effect. Applicant further argues the use of Official Notice in the prior office action rejection of this feature in claim 4, which has been moved to claim 1. Furphy is provided in response to applicant's request that a reference be cited which teaches this feature. The teaching or which may be found in para 0065 of the provided reference (see response to claim 1 above).

Applicant argues that Alnwick does not teach "acquiring said amount and updating said inventory". Applicant further argues the use of Official Notice in the prior office action rejection of this feature in claim 1. Ahluwalia is provided in response to applicant's request that a reference be cited which teaches this feature. The teaching or which may be found in (Ahluwalia, col 11, lines 11-60) of the provided reference (see response to claim 1 above).

Applicant argues that Alnwick does not teach, "notifying said user system that back order request has been satisfied". Applicant further argues the use of Official Notice in the prior office action rejection of this feature in claim 1. Ahluwalia is provided

Art Unit: 3625

in response to applicant's request that a reference be cited which teaches this feature. The teaching or which may be found in (Ahluwalia, col 10, lines 20-37) of the provided reference (see response to claim 1 above).

Applicant argues that Alnwick does not teach "in response to said notifying said user that said back order request has been satisfied, receiving a delivery request from said user system to deliver said product". In response to applicant's amendment of this claim, the examiner provides Pritchard as a reference that teaches the claimed feature and is further supported by Official Notice as stated above in claim 1.

Applicant argues that claims 7-21 are not parallel claims and states that claim 1 is directed to a user system whereas claim 7 has supplier directed activities. It is noted that claims 7-21 are parallel to the features in claims 1-7. In regards to applicant's argument that these supplier activities are not taught by Alnwick the examiner directs the applicant's attention to claim 3 for a rejection of these same supplier activities.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vincent Millin** can be reached on **(703) 308-1065**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

**Alexandria, Va. 22313-1450**

or faxed to:

**(703) 872-9306** [Official communications; including  
After Final communications labeled  
"Box AF"]

**(703) 746-7206** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

A handwritten signature in black ink, appearing to read 'M. A. Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Patent Examiner